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ARENT FOX PLLC
1050 Connecticut Ave., N.W., Suite 400
Washington, DC 20036

In re Application of :
DEL SOLDATO, Pierro :
U.S. Application No.: 10/509,675 :
PCT No.: PCT/EP03/03183 :
Int. Filing Date: 27 March 2003 :
Priority Date: 11 April 2002 :
Attorney's Docket No.: 026220-00055 :
For: DRUGS FOR THE ARTHRITIS :
TREATMENT :

DECISION

The decision is in response to applicant's "Petition Under 37 C.F.R. §1.47(b)" ("Pet.") submitted on 07 September 2005.

BACKGROUND

On 09 March 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee are required. Petitioner was given two-months to respond with extensions of time available pursuant to 37 CFR 1.136(a).

On 07 September 2003, the 37 CFR 1.47(b) applicant submitted the instant petition which was accompanied by, *inter alia*, a \$130.00 petition fee; a \$65.00 surcharge fee; a four-month extension and \$795.00 extension fee; a "Statement Under 37 C.F.R. §3.73(b)"; a copy of an assignment; a copy of an employment agreement; a letter signed by Patrizia Antognazza; an "Affidavit" by Maria Teresa Noro; copies of several letters and postal receipts; and a "Statement Regarding Irreparable Damage to Invention."

DISCUSSION

Petitioner claims that Dr. Piero Del Soldato, the sole inventor, refuses to cooperate due to an employment dispute. Accordingly, the present petition was submitted pursuant to the requirements of 37 CFR 1.47(b).

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor cannot be reached after diligent effort or

refuses to cooperate, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Concerning item (1), the fee for a petition under 37 CFR 1.47 changed to \$200.00 on 08 December 2004. This fee has been charged to Deposit Account No. 01-2300 as authorized.

Concerning item (2), the 37 CFR 1.47(a) applicant submitted an affidavit by Maria Teresa Noro, an attorney practicing in Milan, Italy, who claims that she sent a copy of an application HF 2596 entitled "DRUGS FOR THE ARTHRITIS TREATMENT" to the sole inventor on 14 February 2005 with a copy hand-delivered to his lawyer asking that he respond within fifteen days. Apparently, Mr. Del Soldato never collected the mail delivery as it was returned to sender. Ms. Noro states that she sent another copy of the documents to Mr. Del Soldato and his lawyer on 29 March 2005 requesting a return of the documents in ten days. Ms. Noro declares that "Mr. Del Soldato never sent back to me those documents." Copies of the letters with English translations and postal receipts were included with the subject petition.

Section 409.03(d) of the MPEP discusses a refusal and states, in part:

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient . . .

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition.

After a careful review of this evidence, it is deemed that the conduct of the sole inventor constitutes a refusal to cooperate as explained in the MPEP and is sufficient to meet the requirements of item (2) of 37 CFR 1.47(b).

With regards to item (3), the last known address of the sole inventor is listed as:

Via Enrico Toti 22
20052 Monza
Italy

Concerning item (6), section 409.03(g) of the MPEP states that “[i]rreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage.” Such a statement was provided.

Items (1), (2), (3) and (6) of 37 CFR 1.47(b) are satisfied.

Regarding item (4), section 409.03(b) of the MPEP requires that a declaration signed by the 37 CFR 1.47(b) applicant must be provided. Here, the 37 CFR 1.47(b) applicant has not provided such a declaration. Consequently, item (4) of 37 CFR 1.47(b) is not satisfied.

Finally, section 409.03(f) of the MPEP discusses the proof required to show the requisite proprietary interest required by item (5) of 37 CFR 1.47(b) and states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that:

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application. . . .

Here, the 37 CFR 1.47(b) applicant provided a copy of an assignment filed in the USPTO, an employment agreement signed by the sole inventor on 02 December 1995 and a letter signed by Patrizia Antognazza. A review of the assignment shows that it is based upon the employment agreement, as such, the analysis of (B) will follow.

The employment contract for Mr. Del Soldato shows that employee duties with regards to inventions are discussed in sections 3.1 and 3.2. The employee contract indicates that any intellectual and/or industrial property rights, in particular patent rights, of any kind or nature, which may be created or developed by him . . . shall be the sole property of the Nicox Group.”

Petitioners also submitted a letter by Patrizia Antognazza who declares that “the above-identified invention was made by Dr. Piero Del Soldato in fact I and Dr. Sama wrote a draft of the application based on a draft and on pharmacological results sent to me by Dr. Piero Del Soldato which reviewed and corrected the draft application.”

Section 409.03(f) of the MPEP expands upon the employment agreement

requirement and states:

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. **When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.** (Emphasis added).

The letter by Patrizia Antognazza is deficient in meeting the statement requirement above in that it appears that the author works for outside counsel (with Dr, Daniele Sama) and does not have the requisite firsthand knowledge that the invention was made by Dr. Del Soldato during the period of employment and within the scope of duties contemplated by the employment agreement. Further clarification is needed as a minimum. It is noted that a statement by a person working at Nicox S.A. such as Dr. Del Soldato's supervisor at the time the invention was conceived would be more appropriate. For this reason, item (5) is also not satisfied.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are available.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


James Thomson

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Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302